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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,211	07/02/2003	Marc Van Damme	223328	5720

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,211

Applicant(s)

VAN DAMME ET AL.

Examiner

Barbara L. Gilliam

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/27/04; 12/6/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed December 6, 2004 has been entered and fully considered.
2. The objection under 35 USC 119(e) is withdrawn in light of the Preliminary Amendment filed July 2, 2003.
3. Claims 1-13 are present of which 9-13 are new.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 8, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. It appears claims 8, 11 and 13 should depend from claims 4, 10 and 12 respectively. (The contents of the heat-sensitive coating is claimed in claims 4, 10 and 12.)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 8-12 and 13 are rejected under 35 U.S.C. 103(a) as being obvious over in view of Urano et al. (US 2002/0058207 A1) in view of Inoue et al. (EP 1 145 848 A2).

a. The image-forming material of Urano et al. meets the present limitations for the positive working lithographic printing plate precursor. Specifically the image-forming material of Urano et al. comprises a substrate and a positive photosensitive composition layer. The positive photosensitive composition layer contains a novolak resin and a photothermal conversion material (abstract; [0022]-[0041]). The novolak resin meets the present limitations for the hydrophobic polymer. The photosensitive layer is "heat-sensitive" due to the presence of the photothermal conversion material. The photosensitive layer further contains a solubility-suppressing agent that is considered to lower the solubility of the novolak resin in the alkali developer by forming a hydrogen bond with the novolak resin ([0048]-[0054]). The solubility-suppressing agent meets the present limitations for the water-repellent dissolution inhibitor. The composition can further contain various additives including a development-improving agent ([0056]) which meets the present limitations for the dissolution accelerator. The support is preferably an anodized and grained or electrolytically etched aluminum plate having a surface roughness of from 0.3 to 1.0 μm ([0061]). Urano et al. is silent with respect to the amount of anodized layer formed on the support as a result of the anodizing treatment. However, it would have been obvious to perform the anodizing treatment using conditions that would yield an anodized layer in an amount 2.0 to 6.0 g/m² based on the teachings of Inoue et al. to ensure a sufficient impression capacity ([0136]).

Response to Arguments

8. Applicant's arguments with respect to claims 1-13 have been considered and are unpersuasive in view of the new grounds of rejection.

9. Applicant argued that although Urano et al. discloses a solubility suppressing agent, nowhere does it disclose or suggest the use of a dissolution inhibitor. The solubility suppressing agent of Urano has the same function as the dissolution inhibitor of the present application, to lower the solubility to the resin by increasing the difference in the solubility in the alkali developer between the exposed portion and the non-exposed portion of the photosensitive layer (see Urano et al. [0048] & present specification at page 5, lines 14 – 36).

Allowable Subject Matter

10. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 5 and 6, there is no teaching or suggestion to incorporate a water-repellant polymer as the dissolution inhibitor (solubility suppressing agent) in the

image-forming material of Urano et al. nor is there a teaching or suggestion to incorporate the specific dissolution inhibitor compound of instant claim 7.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 2003/0200886 A1, Vermeersch et al. teach a negative-working thermal lithographic printing plate precursor comprising a smooth aluminum support (abstract; claims).

b. In US 5,998,084, Elsaesser et al. teach a radiation-sensitive recording material for the production of planographic printing plates (abstract).

c. In EP 908 784 A1, Vermeersch et al. teach a method of making positive working printing plate from a light sensitive imaging element (abstract).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
March 18, 2005